

REMARKS

Applicants would like to thank the Examiner for the careful consideration given to the present application. The present application currently has claims 1-15 and 25-28 pending. The application has been carefully reviewed in light of the Office Action. Applicants respectfully submit that the claims are patentable over the cited references for at least the reasons set forth below. Reconsideration of this application is hereby requested.

Claim Rejections – 35 U.S.C. §112

The Examiner has rejected claims 27 and 28 as failing to comply with the written description requirement. The Examiner states that the claim(s) contain subject matter that was not described in the specification in such a way as to reasonably convey that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner has stated that the surface area having a length to width ratio of greater than about 1 and less than about 4 is considered to be new matter.

It is believed that specification provides the support for the claim language in claim 27. Such support is provided in the specification on page 5, lines 10-13. Specifically, the disclosure states that “Generally, the first paint color card has a ... length to width ratio of greater than 1 and less than about 4.”

In light of the foregoing, Applicants believe that the Examiner’s concern has been addressed and that the rejection should be removed.

Claim Rejections – 35 U.S.C. 103

The Examiner has rejected claims 1-4, 10-14, and 27-28 under 35 U.S.C. 103(a) as being unpatentable over applicant’s admitted prior art in the specification in view of Teter et al. (U.S. Patent No. 6,112,665). Applicants traverse this rejection for the following reasons. To establish a *prima facie* case of obviousness, one criterion that must be met is that there must be some suggestion or motivation to combine reference teachings. The teaching or suggestion to make

the claimed combination and reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner states that Applicants admitted prior art discloses the idea of covering a color card with a single color but does not disclose the idea of placing perforations on the card to form a detachable paint chip. Further, the Examiner states that Teter et al. teaches the idea of placing perforations within a colored section in order to allow the perforated area to be removed. The Examiner has combined Teter et al. in combination with Applicants prior art teaching, and has asserted that claims 1-4, 10-14, 27 and 28 are obvious in light of the combined references.

Applicants respectfully submit that there is absolutely no suggestion or motivation to combine the two teachings that the Examiner has used to make the instant rejection. As such, independent claims 1 and 10, and accordingly all claims depending therefrom, are not obvious.

With respect to the Examiner's combination of Applicants prior art teaching and Teter et al., there is no suggestion in either reference to combine the references to arrive at placing perforations on a single-color paint card in order to form a detachable paint chip on such single-color card. The mere fact that the references *can* be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Absent any suggestion or motivation to combine, it cannot be obvious to combine the references.

The Teter et al. reference is specifically directed to "blanks" that are provided for producing color swatches in a printer or photocopier. Neither Applicants disclosure nor Teter provide any motivation to combine the blanks that are provided therein with a single-color color card. The Teter patent is an invention for a blank. The claims in the Teter reference relate to a blank that can be adapted for a printer. The Abstract, Background (see specifically Col. 1, lines 42-45), Summary, and Description have numerous and repetitious references to the fact that the invention is directed to a blank. There would be no motivation, and there is no suggestion, to combine a reference that discloses an invention for blanks with an invention for a single-color color card.

Additionally, the teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art. The Examiner states that it would have been obvious to one in the art to modify Applicant's prior art by adding perforations to form a detachable chip. However, Applicants believe that the Examiner has not shown any

suggestion for the combination. The Examiner has not shown that there is anything in Teter to suggest the desirability, and therefore the obviousness, of making the combination of perforated sections in anything other than a blank that is to be put through a printer or copier to create a multiple-color color card. Other than the Examiner's mere statement that the combination would allow for better color matching – i.e., the Examiner's statement that the references can be combined – there is no evidence to show that there is motivation to combine a reference teaching and claiming blanks with an invention for a paint color card – i.e., there is no showing of a suggestion of desirability of the combination of references.

The Teter et al. reference specifically and solely teaches the use of a color card with a plurality of color swatches. In fact, Teter et al. is the type of color card that Applicants' specification has expressly referenced as being undesirable – a conventional color card with a multitude of colors. The set of perforations within the colored area, as taught by Teter et al. are part of a larger swatch card of multiple colors. Teter et al. in no way suggests the use of perforations with a single-color color card. Throughout the Teter et al. reference, there is mention that the color card includes many colors. Column 4, line 43 *et seq.* states that the stippling in Figs. 4 and 5, i.e., the same figures that the Examiner has used to make the instant rejection, is used to indicate different printed colors. Additionally, the Teter et al. reference is replete with references to more than one color used on the color card. In Col. 4, lines 48-50, of the Teter et al. reference it is taught that the colors of the swatches may be related or totally independent from one another. There is no suggestion to include only a single color on the Teter et al. color card.

Applicants have specifically stated that there are many deficiencies with the use of conventional color cards that exhibit numerous colors (see Specification page 1, line 28 *et seq.*). One deficiency that Applicants have referenced is that the human eye tends to blend colors together when the colors are presented such as they are on a conventional color card of multiple colors. Additionally, the intensity that is imparted to a specific color is not as apparent on a conventional color card as would be on a larger surface, such as a single-color color card. Accordingly, there is no suggestion or motivation to combine a reference that teaches a multiple-color color card, such as Teter et al. with a teaching of a single-color color card.

Furthermore, the distinctions pointed out between single-color and multiple-color color cards, and Applicants teaching of the undesirability of using a multiple-color color card, in fact

teach away from any combination of a single-color color card with a multiple-color color card reference.

The functionality of the single-color color card and the multiple-color color card is completely different and the teachings of the contrasting cards are not compatible for use with one another. Applicants prior art teaching, as discussed above, shows that a single-color card is not consistent with and is contrary to the purposes and functionality of a multiple-color color card inasmuch that a multiple-color color card has many deficiencies that are addressed through the use of a single-color color card. As such, Applicants prior art teaching cannot properly be combined with Teter et al.

Moreover, MPEP Section 2143.01, part IV, states that merely because the references relied upon teach that all aspects of a claimed invention are individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings. *Ex Parte Levengood*, 1993 Pat. App. LEXIS 10, 28 USPQ2d 1300. Because Teter appears to suggest use only through a multiple-color card and the desirability of a multiple-color color card to house many colors, it is believed that the combination of the Teter reference with Applicant's disclosure is one that has been made without objective evidence to show that the two references should indeed be combined. Merely because applicant has generally disclosed the existence of single color cards and because Teter discloses a multiple color card with perforated sections does not suggest the desirability that the two references be combined. There is nothing to show that one skilled in the art would have been motivated to combine these teachings to arrive at Applicant's claims.

Obviousness cannot be established by combining the teachings of the prior art to produce Applicants' claimed invention without some teaching or suggestion supporting the combination. In re Fritch, 972 F2d 1260, 1266 (Fed. Cir. 1992). Under 35 U.S.C. 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *Id.* Again, it appears from Applicants' teachings of deficiencies in the use of multiple-color color cards, and from Teter's disclosure on the desirability of utilizing a multiple-color color card, there is no objective reason why one skilled in the art would combine the references cited by the Examiner when it appears that the statements in Applicants' disclosure and Teter's disclose teach away from combination with one another. Neither Teter nor Applicants' disclosure objectively provide teaching or suggestion to make the Applicants' claimed invention. An Examiner cannot

establish obviousness by locating references which describe various aspects of an applicant's invention without also providing evidence of the motivating force that would impel one skilled in the art to do what the applicant has done. *Ex Parte Levengood*, 1993 Pat. App. LEXIS 10, 28 USPQ2d 1300. The Examiner, other than making a general statement that since Applicants disclose single-color color cards and Teter discloses perforated sections in a multiple-color color card, provides no objective evidence to combine the references. In fact, in light of Teter's expressly disclosed desirability of a multiple-color color card, along with Applicants' express disclosure on the ineffectiveness and undesirability of utilizing a multiple-color color card, it does not appear that there is evidence of an objective motivating force to combine the Teter reference with Applicants' prior art disclosure. Just because the Applicants' disclose can be combined with the Teter reference does not mean that, and no objective evidence appears to have been presented that, there is a suggestion to make the combination. In other words, merely because individual elements of Applicants' claimed invention appear in the prior art references, it does not follow that the references themselves would be combined.

In addition to the above reasons for patentability of the instant claims, the Teter et al. reference does not contemplate that the color on the swatches are formulated to have a dried color that is substantially similar to dried color of a commercially available paint composition. The Teter et al. patent contemplates that the blank swatches are run through a color printer or photocopier to provide for a color on the swatches. There is no motivation to use Teter et al. to exhibit colors similar to commercially available paint colors. In fact, the reference contemplates the ability to make swatches for colors that represent "spot" colors and textiles. Additionally, the swatches may be used to record the color samples that pertain to printing projects or advertising campaigns. Accordingly, there is no suggestion to combine the Teter et al. reference with the prior art teaching in Applicants specification, which discloses a single-color color card for the display of paint. As such, independent claims 1 and 10 are not obvious, and all claims depending from claims 1 and 10 are not obvious.

For the foregoing reasons, Applicants believe that independent claims 1 and 10 are not obvious, and therefore all claims depending from claims 1 and 10 are not obvious.

With respect to claim 2, Applicants also traverse this rejection. Applicants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There is no basis for an obviousness rejection of claim 2 in light of the failure of the references to provide any suggestion or motivation to be combined.

With respect to claims 3 and 13, Applicants traverse this rejection. The Examiner has stated that Applicants prior art in view of Teter does not disclose the chip section. The Examiner states that Teter does not disclose the shape of the chip section and that since Applicants have failed to provide any advantage to making the chip section square, the round shape taught by Teter would work equally well. Additionally, the Examiner states that it would be within one skilled in the art to modify the Teter disclosure of a round-shaped chip section to a square-shaped chip section. Applicants disagree with the Examiner's statements.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). As such, it must be shown that there is suggestion to combine the references, regardless of Examiner's statement that Applicant's have not shown any advantage to making the chip sections square. There must be some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter 1993). As presented above, there is no suggestion for the Examiner's combination of Applicants' prior art statement and the Teter reference. Teter's invention, as discussed above, is a blank that can be put through a printer or copier. The Examiner has not provided an objective reason for why a reference disclosing and claiming blanks should be combined with a paint color card. Furthermore, there must be support or explanation for the Examiner's assertion that such modification is within one skilled in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The Examiner has not provided any support or explanation for his conclusion that one skilled in the art would have combined the Applicants teachings with Teter.

The failure to provide any teachings for a generally square chip sections, in addition to the fact that the independent claims are not obvious, support a finding that claims 3 and 13 are also not obvious.

With respect to claims 4 and 14, 27 and 28, Applicants also traverse this rejection. Applicants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There is no basis for an obviousness rejection of claims 4 and 14 in light of the failure of the references to provide any suggestion or motivation to be combined, as discussed above.

The Examiner has rejected claims 5-7 and 15 under 35 U.S.C. 103(a) as being unpatentable over Applicants admitted prior art in view of Teter et al. and further in view of Day et al. Applicants traverse this rejection. Applicants prior art discussion as provided in the specification of the subject application and the Teter et al. reference cannot properly be combined because of the lack of suggestion or motivation to combine them. Applicants have provided arguments in favor of this position with respect to independent claims 1 and 10, above. As such, dependent claims 5-7 and 15 also cannot be obvious.

The Examiner has rejected claims 8 and 25 under 35 U.S.C. 103(a) as being unpatentable over Applicants prior art discussion in the specification in view of Teter et al. and further in view of Edwards (U.S. Patent No. 4,992,050) or Goldsholl (U.S. Patent No. 3,224,113). Applicants traverse this rejection for the following reasons. As Applicants have stated above, Applicants prior art discussion and Teter et al. are not properly combinable because there is no suggestion or motivation to combine the references. As such, independent claim 1 is not obvious and claim 8, depending from claim 1, is also not obvious. Applicants also believe that claim 10 is not obvious for reasons set forth above, and as such, claim 25 is also not obvious.

The Examiner has rejected claims 9 and 26 under 35 U.S.C. 103(a) as being unpatentable over Applicants prior art discussion in the specification in view of Teter et al. as applied to claim 1 and 10 and further in view of Goldsholl. Applicants traverse this rejection for the following reasons. As Applicants have stated above, Applicants prior art discussion and Teter et al. are not properly combinable because there is no suggestion or motivation to combine the references. As

such, independent claims 1 and 10 are not obvious and claims 9 and 26, depending from claims 1 and 10 respectively, are also not obvious.

The Examiner has rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over Applicants prior art discussion in the specification in view of Teter et al. as applied to claim 10 and further in view of Simson. Applicants also traverse the rejection of claim 11.

Simson discloses an advertising insert that includes perforated openings. The Examiner states that Simson shows in Figure 2 the idea of creating a window with a tear line that includes a non-perforated space between the ends of the tear line. The Examiner further states that it would have been obvious to make the paint chip section with a perforated line and with a non-perforated space because doing so would make the card more “user-friendly”. Applicants do not believe that it would be obvious to combine the teachings of Applicants’ disclosure, Teter and Simson.

Initially, the Simson reference states that each of the windows (34-36) are severable along three lines. However, it would not be obvious to combine the Simson reference with the teaching of a single-color color card or the Teter reference. The Simson reference expressly states that by folding the flap along the tear lines (40, 41 or 42), a portion of the panel can be lifted up to expose information printed on the juxtaposed panel that has been folded behind the panel. As such, the Simson reference does not contemplate or suggest that the “window” be used for any type of color reference, guide or comparison. Because the Simson disclosure illustrates a magazine insert, it would not be obvious to combine the reference for use of certain features disclosed therein with a paint color card. Not only is there no suggestion for providing color comparisons or matching through use of the window, but also, the fact that the Simson reference is discussed in the context of a magazine insert and mailing envelope, it would not be obvious to one skilled in the art to combine the teaching of Simson with teachings of color cards.

Moreover, Examiner has provided no objective evidence to demonstrate a motivation to combine the Simson reference with either or both the teaching of a single-color color card or the Teter color card. As stated above, *Ex Parte Levengood*, 1993 Pat. App. LEXIS 10, 28 USPQ2d 1300 and MPEP Section 2143.01, part IV, state that merely because the references relied upon teach that all aspect of a claimed invention are individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings. There is no express or implicit suggestion to incorporate the single element of liftable

flaps into a paint color card. Regardless of the notion that the individual elements in Applicants' claim may be taught, there is no motivation to combine the references in which the elements are taught. In general, any number of references can be pieced together, but it is the objective motivation or suggestion to do so that should render claims obvious – and neither the motivation or suggestion appear to be present in the case at hand. The Examiner merely makes a non-objective assertion that the Simson feature would make the color card more user-friendly. The mere fact that references can be combined or modified does not render the resultant combination obvious absent a suggestion to make the combination. (See *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)). In this case, the suggestion to make the combination appears to be made by the Examiner, and not by the references themselves. Thus, it is believed that claim 11 is not obvious.

Additionally, because independent claim 10 is nonobvious, then any claim depending from the independent claim is also nonobvious.

Applicants would like to again thank the Examiner for his review of the subject application. In light of the foregoing, Applicants are hopeful that the present application is in a condition for allowance.

Respectfully submitted,

THE SHERWIN-WILLIAMS COMPANY

By: /Arthi K. Tirey/

Arthi K. Tirey
Attorney for the Applicants
Reg. No. 50,960

October 9, 2007

The Sherwin-Williams Company
11 Midland Bldg. - Legal Dept.
101 Prospect Avenue, N.W.
Cleveland, Ohio 44115
Phone: (216) 566-3650